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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,319	09/23/2003	Jerry Rayborn	P-0038US	9260

7590

02/21/2006

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EXAMINER
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TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/667,319

Applicant(s)

RAYBORN, JERRY

Examiner

Philip C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-22 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-22 and 24-30 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-9,11-17,31 and 32 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (5925182).

Patel teaches a suspension which may be used in wellbores, which can comprise an oil, a glycol and graphite (see claim 1). Patel differs in that a specific example of such a combination is not disclosed. It would however be obvious to one of ordinary skill in the art to utilize a combination of oil and glycol, with the graphite in the suspension of Patel, given the specific teaching of Patel that combinations of the liquid carrier may be used. Applicants claim is not seen to distinguish, since a combination of all components would be formed in the additive. Furthermore, the ranges of 1-99% of claim 32 would clearly be rendered obvious by the teaching of the combination of carriers by Patel, since such covers almost the entire possible spectrum of relative amounts.

3. Claims 1, 3, 4, 6-9, 11-14 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rayborn (4063603) in view of DeBeer (5401719).

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Rayborn teaches a drilling fluid additive comprising copolymer beads within the scope of the present invention as a lubricant (see column 2, lines 48-58). Rayborn further teaches that such can be added in a vegetable oil to the drilling fluid (column 3, lines 44-49). Rayborn differs from the present invention in that the use of graphite is not taught. De Beer teaches the use of graphite to improve lubrication properties of a drilling fluid (see column 2, lines 15-33). Case law has held that the utility of two or more compositions in combination, for that which they are individually taught useful is not a patentable distinction (*In re Kerkhoven* 205 USPQ 1069). It would be obvious to one of ordinary skill in the art to use the graphite mixture of DeBeer in combination with the mixture of vegetable oil and polymer bead of Rayborn, given that such are individually taught as being useful in forming a lubricant for addition to drilling fluids. This is particularly true since Rayborn teaches that combinations with other lubricants aids the function in the wellbore (column 3, lines 44-49).

4. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 18-22 and 24-30 are allowable over the art of record.

6. Applicant's Terminal Disclaimer has overcome the obviousness double patenting rejections. Applicant's other arguments have been considered but are not deemed

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persuasive. With respect to claim 31, such is claimed as a composition and not a method. Clearly in combining the mixtures, one would create a mixture comprising graphite, oil and glycol. The oil and glycol would clearly mix together, and is not seen to be distinguishing over the mixture made obvious by Patel. Applicant uses the term "comprising" in the claims, and such is not seen as being distinguished from the composition of Patel which includes a fatty acid or salt, since "comprising" opens the claim to include any other component imaginable.

7. With respect to Rayborn in view of DeBeers, applicant argues that there must be reason to combine references. As noted in the cited case law of Kerkhoven 205 USPQ 1069 it has been well established by the courts that the utility of two or more compositions in combination, for that which they are individually taught useful is not a patentable distinction. In the present case both graphite and copolymer beads are taught as lubricants for drilling fluid systems, and their utility together would be obvious to one of ordinary skill in the art. Furthermore, the destruction of the composition would not occur, since both of the fluids involved are drilling fluids. The function of the beads cannot be destroyed in view of the teaching of Rayborn that a combination with other lubricants aids the function in the wellbore (column 3, lines 44-49). Clearly when the vegetable oil is used as a carrier, such would coat the beads and graphite. No distinction is seen for the current claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

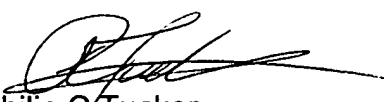
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Philip C Tucker  
Primary Examiner  
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